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In re Application of	:
Joel C. Barrish et al	:
Serial No.: 10/027,982	: PETITION DECISION
Filed: December 20, 2001	:
Attorney Docket No.: QA0238 NP	:

This is a decision on the petition under 37 CFR 1.144, filed January 6, 2003, requesting withdrawal of an improper restriction requirement.

#### BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 111 and contained, as filed, 22 claims. The examiner assigned to the application mailed applicants a first Office action on March 11, 2002, dividing the claims into two groups for examination purposes, as follows:

Group I, claims 1-19, drawn to products of Formula I, variously classified;  
Group II, claims 20-22, drawn to methods of use of the products of Formula I, variously classified.

In addition, the election of a single species within whichever group was elected, was required. Applicants replied on April 18, 2002, electing Group I and compound 76 as the species, with traverse, contending that there is no serious burden on the examiner in searching the compounds and methods of use.

The examiner mailed an Office action to applicants on May 10, 2002, maintaining the restriction requirement and arguing that the compounds and methods of use are classified and searched separately. From the species elected the examiner created a generic concept of what was searched which is subgeneric to the compounds of Formula I in claim 1. The Office action objected to the claims as containing subject matter not encompassed within the concept drawn. Claims 1-14, 16-19 and 20-22 were then objected to as containing non-elected subject matter.

Applicants replied by canceling claims 1-6 and 20-22 and amending claims 7, 9 and 17. Applicants argue that the examiner is without authority to cast or recast applicants Markush claim in a narrower "generic concept" when no invalidating prior art is found.

The examiner replied by mailing a Final Office action to applicants on November 5, 2002, maintaining the objection to the claims as containing non-elected subject matter. The examiner continued to maintain that there are numerous independent and distinct inventions within applicants' claimed subject matter and that applicants have not argued to the contrary, but have argued a lack of unity standard which is improper as there is no special technical feature present. Applicants filed this petition to withdraw the holding of the examiner with respect to the restriction requirement on January 6, 2003.

## DISCUSSION

As a first observation, it is noted that original claim 1 encompasses an incalculable number of individual compounds set forth in Markush format and including Formula I, the generic structural formula and excluding compounds defined by Formulas X, XI, XII(a) and (b), XIII, XIV, XV(a) and (b), XVI and XVII. Because of the extensive provisos within the claim it is clear that the claim was exceptionally broad and confusing such that numerous compounds were encompassed therein that would not be patentable. Also each of the variables was identified as having numerous values, usually more than 10 and frequently more than 100. The claim, as presented thus clearly encompassed numerous compounds which lack unity or common structure with each other.

In order to facilitate examination the examiner made first a restriction requirement under 35 U.S.C. 121 between the compounds and methods of use of the compounds, which restriction was proper. The examiner also required an election of species within whichever group was elected thus binding the examiner to follow the guidelines in M.P.E.P. 803.02. The guidelines state that the elected species will be examined appropriately and if found to be free of prior art which anticipates or renders obvious the species then the examiner will expand the search and examination to a reasonable number of other related species to determine if they are also free of the prior art. In doing this the examiner generally creates a subgeneric concept based on the species which is less than the generic concept defined in the claims. If no prior art is then found based on search and examination of the subgeneric concept the application will be allowed.

It appears that the examiner in this instance did examine the species and found it to be free of the prior art and then expanded the search and examination to additional species as defined by the subgeneric concept created. As a courtesy to applicants the examiner defined the extent of the search and examination by indicating the subgeneric concept which has unity with the elected species. The examiner then attempted to require applicants in their reply to the Office action to limit their claims to the subgeneric concept examined. As such this was improper without identifying to applicants those compounds which are not within the species or subgeneric concept - i.e. those compounds which the examiner alleges are independent and distinct from the allowed concept - which would not have unity with the species elected and could have withdrawn by

means of a restriction requirement within the claim. It is not incumbent upon applicants to define to the examiner compounds which are not within the realm of the elected species or subgeneric concept developed and searched by the examiner and which could be withdrawn by means of a restriction requirement.

The concept of unity of invention, as it relates to cases filed under 35 U.S.C. 111 does not require the presence of a "special technical feature" as does the concept of Unity under PCT Rule 13. Thus the examiner's argument based on a requirement for a "special technical feature" is flawed in this aspect. Unity here only requires a common structure which structure does not itself have to define over the prior art.

Applicants, in reply to the first Office action following the restriction requirement did significantly reduce the scope of the independent claim, but not to the subgenus limits searched and examined by the examiner. As a consequence, the examiner mailed a Final Office action to applicants repeating the requirement to limit the claims to the subgenus examined. The examiner has not provided any evidence that the unexamined portions of the currently claimed genus is/are not patentable and therefor they have not been rejected. The examiner's objection to the pending claims as containing non-elected subject matter (i.e. - subject matter which supposedly does not have unity with the generic or subgeneric concept) has not been supported by the examiner and must therefor be withdrawn.

Further, the examiner's formula representing the subgeneric concept examined is confusing in that  $Z_4$  is defined as three separate values - in one instance it is a single bond, in another it is an alkyl group and another an aryl group, however, these groups are not interchangeable depending on where  $Z_4$  appears.

#### DECISION

Applicants' petition is **GRANTED**.

**The last Office action is withdrawn as improper. The application will be forwarded to the examiner for consideration of the reply filed January 6, 2003, and preparation of a new Office action.**

**There is no fee for this petition and the petition fee paid of \$130.00 will be credited to applicants' Deposit Account No. 19-3880, as directed.**

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230.

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